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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/597,659

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EXAMINER

MERENE, JAN CHRISTOP L

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

11/15/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/597,659

Applicant(s)

ZEITANI, JACOB

Examiner

JAN CHRISTOPHER MERENE

Art Unit

3733

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 November 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-13.
Claim(s) withdrawn from consideration: 14.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/EDUARDO C. ROBERT/
Supervisory Patent Examiner, Art Unit 3733

/Jan Christopher Merene/
Examiner, Art Unit 3733

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments filed November 2, 2010 have been fully considered but they are not persuasive. In response to applicant's arguments (pages 5-8 in the reply), the recitation "a sternum reinforcing device to be used after a sternum sternotomy or a sternal fracture" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Claim 1 does recite that the elongated member "designed to be located on a surface portion of an anterior longitudinal edge of a sternum" which discloses where the elongated member can be placed, where Raymond would be capable of being placed at a location on a surface portion of an anterior longitudinal edge of a sternum. Likewise, the applicant also claims the projecting portion "designed to be fitted in an intercostals space adjacent to the longitudinal lateral edge of the sternum," which again deals with the placement of the device. There is nothing in the claims other than the location of where the device is intended to be placed that further limits how the device "reinforces" the sternum. Likewise, the applicant is NOT claiming a plurality of elongated members, only one elongated member with first and second connection parts in the form of arms and a projecting portion. It is believed that the "reinforcement" is due to the plurality of elongated members as disclosed in the current specification and seen in the Figures but applicant is not claiming that.

In claim 2, applicant argues that there are no arms but see annotated figure on page 5 which shows two arms.

Regarding claim 3, the applicant is claiming the elongated member is made from a biocompatible shaped and bent plate material. The applicant has claimed an elongated member comprising different parts. The applicant is not claiming which portions of the elongated member is made from a bent plate material.

Regarding claim 4, the projecting portion of Raymond can be placed in the intercostal space if one chooses to do so.

Regarding claim 5, the applicant is not claiming an attachment means, only a stainless steel wire.

Regarding Claim 6, see page 10 where the free edges form a u shape. The applicant is not claiming legs that could be bent in opposite directions.

With regards to claim 9, 11-12, although the ratchet arms are separate components, there can still be considered as being part of the elongated member. Likewise, the applicant is not claiming that the arms are monolithic and applicant has already claimed an elongated member comprising a plurality of parts.

Regarding Claim 10, the profile is still rectangular and applicant is not claiming anything regarding thickness.

Regarding claim 13, the examiner believes the applicant is trying to convey in his reply that the edges can be bent as opposed to already being bent but applicant is not claiming this. See bottom of page 9 and top of page 10 of the previous action where button is used to clamp another arm.

As applicant has pointed out, the device of Raymond is a retractor but it is still capable of performing the claimed functions of being located in the claimed locations. Likewise, the applicant is only claiming one elongated member and the one elongated member of Raymond reads both on the structural and functional claimed limitations. With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Raymond which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., see above) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In short, applicant is not claiming a plurality of elongated members and now they are arranged to form a "reinforcement" and also relies on a number of features that are not recited in the claims. The applicant should recite how the elongated member reinforces the sternum and recite non-claimed features into the claims in order to further define the current invention and could potentially overcome the Raymond reference.

With regards to the IDS submission, please see CFR 1.97 for the proper steps in submitting an IDS after a final office action has been mailed out.